

Application Serial No. 09/509,869  
Attorney Docket No. 21547-00268-US

**R E M A R K S**

Claims 1-16 are pending. Claim 1 is independent. Claims 8 and 9 have been amended. Applicants respectfully request reconsideration and withdrawal of the Final Rejection mailed March 26, 2002.

***Reason for Entry of Amendments***

Claims 8 and 9 have been amended to correct informalities in the claims and no new issues have been introduced.

***Rejection Under 35 U.S.C. § 102(b)***

Claims 1-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by O'Brien. Applicants respectfully traverse.

Applicants hereby reassert the arguments presented in Applicants' response filed January 7, 2002, which the Examiner failed to address in the Final Office Action. Specifically, the Examiner failed to demonstrate that O'Brien discloses a threaded implant where "the implant threading has a slight conicity which extends along most or part of the length of the implant" in which "said conical threading comprises two or more thread spirals." By contrast, the self-tapping threads 50 of figures 5-7 (see also column 6, lines 17-20) that the Examiner equates to the claimed "conical threading" is a single thread spiral.

The Examiner's statement that O'Brien discloses "a threaded implant 10 which is tapered and has two different types of threads for cutting into different types of bone tissue" does not address the above claim limitation. While O'Brien's implant body 10 does comprise a distal end 20 and a coronal end 18, the ends having different thread configurations, only the distal end 20 can be construed as having conicity. Claim 1

Application Serial No. 09/509,869  
Attorney Docket No. 21547/0268

requires that the "conical threading comprise two or more thread spirals," not simply that two or more thread spirals be present in the implant threading. Because multiple thread spirals are not present in the distal end 20, O'Brien cannot anticipate claim 1.

Anticipation of a claim requires the disclosure of each and every recitation as set forth in the claims in a prior art reference. *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986); *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986). In this case, O'Brien fails to disclose the claimed conical threading with two or more thread spirals, and therefore cannot anticipate claim 1.

In light of the above remarks, the rejection based on O'Brien should be withdrawn.

The Examiner has also failed to address the limitations included in the dependent claims. Instead, in the Office Action, the Examiner only concludes that claim 1 is anticipated. The following is a nonexclusive list of examples of features recited in the dependent claims that are not shown by O'Brien:

Claim 3 recites that a "front portion of the implant is designed with a conical thread which has a conicity essentially exceeding the conicity of the slightly conical thread." O'Brien does not disclose two degrees of conicity in a threaded portion.

Claim 4 recites:

...the conicity of the slightly conical thread is chosen between 0.1 - 0.4 mm or has an angle of inclination of about 0.5 - 2°, and/or the thread conicity of the thread at the said front portion of the implant is of the order of 0.4 - 0.8 mm or with an angle of inclination of about 10 - 15°,

Application Serial No. 09/509,869  
Attorney Docket No. 21547-00268-US

and the front portion of the implant has a length or height of about 10 - 30% of the length of the threaded part of the implant.

O'Brien does not disclose the conicity values recited in claim 4.

Claim 11 recites that a "number of thread spirals is adapted to the number of cutting edges so that symmetrical cutting forces are obtained." O'Brien does not disclose a number of thread spirals adapted to a number of cutting edges. Claim 12, which recites a relationship between thread spirals and cutting edges, is likewise not anticipated by O'Brien.

Claim 15 recites that "the implant is arranged with a minimum diameter that is 1-5% greater than the diameter of the hole in the bone substance." O'Brien does not disclose this range of negative tolerances.

Claim 16 recites that "four thread spirals are arranged together with four cutting edges." O'Brien does not disclose four thread spirals with four corresponding cutting edges.

Therefore, the rejection based on O'Brien should be withdrawn. In addition, because the Examiner has failed to address the limitations of claim 1 and of the dependent claims in the Final Office Action, the finality of the office action should be withdrawn. A Final Rejection is improper unless the grounds for rejection are "clearly developed to such an extent that the Applicant may readily judge the advisability of an appeal." See MPEP 706.07.

Application Serial No. 09/509,869  
Attorney Docket No. 21547/0268

*Conclusion*

In view of the above, reconsideration and allowance of the application are respectfully solicited. If the Examiner finds the above arguments unconvincing, Applicants request withdrawal of the finality of the Final Office Action and an evaluation of the claims on their merits.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 21547-00268-US from which the undersigned is authorized to draw.

Respectfully submitted,

*Larry J. Hume*  
Larry J. Hume, Reg. No. 44,163  
Connolly Bove Lodge & Hutz LLP  
Customer Number 30678  
1990 M Street, N.W.  
Washington, D.C. 20036-3425  
Telephone: 202-331-7111

Application Serial No. 09/509,869  
Attorney Docket No. 21547-00268-US

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

8. (Three Times Amended) Implant according to claim [1] 7, wherein the peripheris of the different non-circular or eccentric thread cross-sections have bevelled corners.

9. (Three Times Amended) Implant according to claim [1] 7, wherein the non-circularity is arranged such that areas of maximum diameter are displaced in the peripheral direction from one thread turn to the next thread turn.